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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte
RICHARD C. BELLOFATTO, JR., MARK T. SALANDER,
JOSHUA B. LEDERER, and QUINCY L. REESE

Appeal 2008-3775
Application 10/696,963
Technology Center 3700

Decided: September 23, 2008

Before DONALD E. ADAMS, RICHARD M. LEOVITZ, and
FRANCISCO C. PRATS, *Administrative Patent Judges*.

LEOVITZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 21-25.
Jurisdiction is under 35 U.S.C. § 6(b). We reverse.

STATEMENT OF THE CASE

Claims 21-25 are pending and appealed. The claims stand rejected as follows:

- 1) Claims 21-24 under 35 U.S.C. § 102(b) as anticipated by Seamon (US Application 2002/0121322 A1, published Sep. 5, 2002) (Ans. 3); and
- 2) Claims 21-25 under 35 U.S.C. § 103(a) as obvious over Seamon (Ans. 4-5).

Claims 21 and 22 are the only independent claims on appeal and read as follows:

21. A padfolio having an exterior pocket along an exterior cover comprising:

a pair of opposing covers joined together by a spine on an edge of each of the opposing covers;

the exterior pocket being located on an exterior surface of one of the opposing covers, wherein the pocket is formed by a flap joined along a base edge, the base edge being joined the exterior surface adjacent to the spine;

the flap including a front edge unjoined to the exterior surface and thereby constructed and arranged to receive documents through the front edge, the flap further including two side edges, each side edge having a recess taper to partially reveal whether at least a single document is held within the pocket while the flap is tensioned against the exterior surface; and

a pair of elastic strips connected between each side edge, respectively, and the exterior surface, the elastic strips generating tension and being constructed and arranged to maintain a holding friction against the documents, and the front edge and the two side edges being unattached to the cover except by the pair of elastic strips while a region in which documents may be viewed is visible along the side edges remote from the straps.

22. A padfolio with an exterior pocket along an exterior cover comprising:

a flap attached adjacent to a spine of the padfolio, where the flap creates a base edge adjacent to the spine, two side edges, and a front edge;

the front edge unattached to the exterior cover, and the front edge being adapted to allow documents to slide into the pocket through the front edge;

an outer perimeter edge stitched on the exterior cover in an approximately rectangular shape with one side adjacent to the base edge and the approximately rectangular shape being slightly larger than the flap; and

the two side edges being unattached except by a pair of elastic strips attached between plies of the flap and the outer perimeter edge, and the two side edges including a taper defined as a gap between the outer perimeter edge and the side edge being narrower at the base edge and wider at the front edge, the taper partially revealing at least a single document within the pocket when the flap is tensioned against the exterior cover by the elastic straps.

ANTICIPATION

Claims 21-24 stand rejected under 35 U.S.C. § 102(b) as anticipated by Seamon.

Findings of Fact (FF)

1. Claim 21 is directed to a “padfolio having an exterior pocket along an exterior cover.” The padfolio has the following elements (the bolded numbers are in reference to a preferred embodiment shown in Figure 1; we do not limit the claims to this embodiment, but refer to it for illustrative purposes as a way of visualizing the claim language):

- (1) two covers joined by a spine;
- (2) an exterior pocket on the exterior surface of one of the covers;

(3) the pocket is formed by a flap which is joined along the base edge of a cover spine;

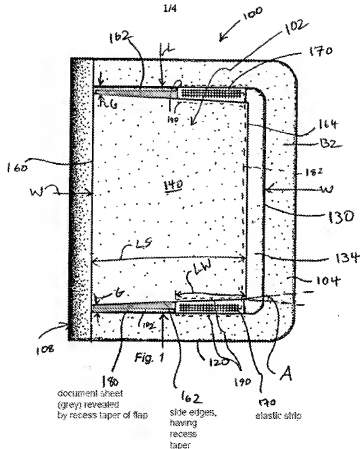
(4) the front edge of the flap is “unjoined” and is “constructed and arranged to receive documents through” its front edge;

(5) the flap has two recessed side edges [162], where “each side edge having a recess taper to partially reveal whether at least a single document is held within the pocket [180] while the flap is tensioned against the exterior surface”; and

(6) the side edges [162] are attached to the cover by “a pair of elastic strips” [170], where “the elastic strips [are] generating tension and being constructed and arranged to maintain a holding friction against the documents . . . while a region in which documents may be viewed is visible along the side edges remote from the straps [sic, strips?].”

2. Claim 22 is directed to a padfolio having a taper and elastic strips as in claim 21, where “the taper [is] partially revealing at least a single document within the pocket when the flap is tensioned against the exterior cover by the elastic straps.”

3. Figure 1, reproduced below, shows a preferred embodiment of a padfolio (the drawing has been annotated by shading the region 180 which shows the exposed partial document.



Analysis

The principal issues in this rejection are:

- 1) whether Seamon describes an openable pocket with side edges having a “recess taper” that partially reveal a document enclosed in it as recited in claims 21 and 22 (*see* FF1, (5); FF2); and
- 2) whether Seamon describes the pocket as having a flap attached by “elastic strips” which “maintain a holding friction against” the document and which is “tensioned against” the exterior surface/cover of the handbag also as recited in the claims (*see* FF1, (5)-(6); FF2).

The Examiner finds that Seamon’s handbag with an openable pocket has a “flap further including two side edges, each side edge having a recess taper (as shown in Figure 2 embodiment the area above the straps 14 where there is no connecting material, form recesses in the side edges) which will partially reveal whether at least a single document is held within the pocket while the flap is tensioned against the exterior surface” (Ans. 3). The Examiner states that it is “common sense” that the straps 14 shown in Figure 2 would be elastic, as required by claims 21 and 22, “for the purpose of allowing the exterior pocket to be stretched out so the contents could be removed easily” (*id.*).

Anticipation requires that every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383 (Fed. Cir. 2001). In this case, we do not agree with the Examiner that Seamon describes all the elements of claims 21 and 22.

Claims 21 and 22 explicitly require the padfolio flap to have side edges with a “taper” that partially reveal a document enclosed by the pocket

(FF1, (5); FF2). That is, because the sides edges of the flap are tapered, a part of a document enclosed by the pocket is still visible when the flap is “tensioned against the exterior surface” of the padfolio as required by the claims (*id.*). This configuration is depicted in Figure 1 (reproduced above). See Figure 1, elements **162** and **180**.

There is no teaching in Seamon of a pocket with side edges that have a “taper” which would partial reveal an enclosed document when tensioned shut as required by claims 21 and 22. The Examiner asserts that Seamon’s pocket in Figure 1 “clearly appears to be tapered between a wider length at the base edge and a narrower length at the front edge” (Ans. 4). However, even could this shape be gleaned from this drawing, no evidence has been presented by the Examiner, nor a sound basis to believe that, when the pocket is closed (*i.e.*, “tensioned against the exterior” surface or cover), a document inside the pocket would be “partially reveal[ed]” as in claims 21 and 22. While the PTO does not have the ability “to manufacture products or to obtain and compare prior art products,” *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977), the burden of showing non-anticipation does not shift to the applicant until “the PTO shows sound basis for believing that the products of the applicant and the prior art are the same” *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990)).

As argued by Appellants:

By definition, the outer zipped cover of Seamon *must* cover the pages inside of the pocket to allow it to be zipper closed without being obstructed by documents, and therefore Seamon does not reveal, in any respect, whether there are any documents held within the pocket, in direct contrast to applicant’s claimed structure. Thence, this pocket configuration

of Seamon does not enable documents to be viewed and thus does not anticipate applicant's claimed invention.

(Reply Br. 14.)

We also do not agree with the Examiner that it is "common sense" that straps **14** in Seamon's pocket are elastic (Ans. 3). Seamon characterizes the straps as useful to hold back "full extension" of the pocket **11** (FF4).

The straps 14 of Seamon perform an entirely opposite function of preventing the pocket from further extension which is converse to the purpose of applicant's elastic strips, which generate *tensorion* to maintain a holding friction *against the documents*. A reading of the Seamon reference describes that the straps 14 in fact maintain the pocket in an *extended position* that is stopped from further extension beyond an already opened orientation, while conversely the elastic strips 170 of applicant's claimed invention maintain the pocket in an *un-extended position*.

(Reply Br. 11.) Moreover, if elastic were utilized as proposed by the Examiner, the pocket would be unable to "swing[] out" as Seamon states that it does (FF4; Reply Br. 12).

Even were no closure utilized for the pocket in Seamon's handbag (FF5), we do not agree that the "logical conclusion" would be that elastic would be necessary to prevent the exterior pocket from "hanging open" and "spilling out" its contents as asserted by the Examiner (Ans. 3). As argued by Appellants, other configurations could be utilized to keep the pocket (Reply Br. 12). "Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981); *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 630 (Fed. Cir. 1987).

For the foregoing reasons, we reverse the rejection of claims 21 and 22. We also reverse the rejection of claims 23 and 24 which depend on claim 22.

OBVIOUSNESS

Claims 21-25 stand rejected under 35 U.S.C. § 103(a) as obvious over Seamon.

Analysis

The Examiner takes the position that the “taper” of the claimed flap which partially reveals a document enclosed within the pocket when “the flap is tensioned against the” exterior surface of the cover (*see* FF1 (5)-(6) & FF2) would have been obvious to persons of ordinary skill in the art “as a matter of obvious design choice, since such a modification would have involved a mere change in the shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966)” (Ans. 5).

We reverse this rejection. In making an obviousness determination, the level of skill in the art is one of the factors to be taken into consideration. *Graham v. John Deere*, 383 U.S. 1, 17 (1966). The Examiner concludes that a change in shape of the flap recited in claims 21 and 22 was “a matter of obvious design choice” that was “within the level of ordinary skill in the art” (Ans. 5). However, the Examiner has not provided any information or evidence from which such a conclusion could be drawn. In particular, the Examiner has not established that the flap shape was one of the parameters a skilled worker would ordinarily vary or consider when making a handbag pocket. We do not take *Dailey* to establish a per se rule that any change in shape of a prior art structure is a design choice that would have made by

persons of ordinary skill in the art. There is still a need to establish the level of skill in the art, including the kind of design activities ordinarily carried out by skilled persons in the relevant art.

In addition to this, while no *explicit* suggestion in the prior art is necessary to establish prima facie obviousness, the Examiner still has a burden of explaining why a person of ordinary skill in the art would have been prompted to modify the prior art to make the claimed invention, i.e., a flap with tapered side edges that partially reveal a document when the flap is tensioned shut over it. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (“[T]here must be some articulated reasoning *with some rational underpinning* to support the legal conclusion of obviousness.” (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added))). Because the Examiner has not satisfied this burden, we reverse the rejections of claims 21-25.

REVERSED

cdc

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